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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,413	12/14/2000	Santokh S. Badesha	D/A0592Q	8801

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John E. Beck
Xerox Corporation
Xerox Square 20A
Rochester, NY 14644

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/737,413

Applicant(s)

BADESHA ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 20, 2003.

Claims 1-21 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Swift et al (U.S. 6,381,436).
4. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) where the silicone elastomer is a polyorganosiloxane wherein the polyorganosiloxane has the same formula displayed in claim 7, where R is hydrogen or substituted or unsubstituted alkyl, alkenyl or aryl having less than 19 carbon atoms, each of A and B may be any of methyl, hydroxy or vinyl groups and $0 < m/n < 1$

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and $m+n > 350$ (column 4, lines 10-24). Additionally, the reference has the same formula limitation presented in claim 2, where W is usually potassium; X, Y are aluminum, magnesium, iron or lithium and Z is silicon or aluminum (column 5, lines 40-46). Badesha discloses the formula in claim 9 where n" is 350 to 2700 (column 7, lines 1-10). Badesha discloses 10% weight of the mica-type silicate (column 5, lines 9-10) where the mica-type silicate comprises hectorite (column 14, lines 9-10). An image *for forming images on a recording medium* is directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A development component *to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface* is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ

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964, 966. Although Badesha teaches transferring, the reference does not explicitly teach a transfix member.

Swift teaches an image forming apparatus comprising a charging station, developer, transfer station and intermediate transfer belt that transfer toner to a fuser or transfix component (column 4, lines 39-47) having an adhesive disposed therein (column 4, lines 49-57).

Badesha and Swift are analogous art because they are both from the field of image forming machines. It would have been obvious to one of ordinary skill in the art to include the transfix component of Swift in the image forming apparatus of Badesha because Swift teaches interchanging the fuser and a transfix component in order to receive toner to be fixed to a substrate (column 4, lines 39-49).

Claim Rejections – 35 USC § 103(a)

5. Claims 1-17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Badesha et al. (U.S. 6,482,504).

6. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer component and a fixing component (column 1, lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) where the silicone elastomer is a polyorganosiloxane wherein the polyorganosiloxane has the same formula displayed in claim 7,

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where R is hydrogen or substituted or unsubstituted alkyl, alkenyl or aryl having less than 19 carbon atoms, each of A and B may be any of methyl, hydroxy or vinyl groups and $0 < m/n < 1$ and $m+n > 350$ (column 4, lines 10-24). Additionally, the reference has the same formula limitation presented in claim 2, where W is usually potassium; X, Y are aluminum, magnesium, iron or lithium and Z is silicon or aluminum (column 5, lines 40-46). Badesha discloses the formula in claim 9 where n" is 350 to 2700 (column 7, lines 1-10). Badesha discloses 10% weight of the mica-type silicate (column 5, lines 9-10) where the mica-type silicate comprises hectorite (column 14, lines 9-10). An image *for forming images on a recording medium* is directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A transfer component *for transferring said developed image from said charge-retentive surface to an intermediate transfer component* and an intermediate transfer component *for receiving said developed image from said transfer component* are also directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A development component *to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface* is a product by process claim

limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Although Badesha teaches transferring, the reference does not explicitly teach a transfix member comprising a transfix substrate comprising a fabric.

Badesha '504 teaches an image forming apparatus comprising a charge-retentive surface, a development component and a transfix member (column 3, lines 44-59). Badesha '504 further teaches a transfix member, wherein said substrate comprises a material selected from the group consisting of fabrics and metals, where the fabric material is selected from the group consisting of graphite fabric, fiberglass, cellulose and polyxylene (column 10, lines 39-48) where the transfix member comprises silicone material and a heating component associated with said substrate (column 10, lines 52-65). Badesha '643 and Badesha '504 are analogous because they are both from the field of image forming apparatus. It would have been obvious to one of ordinary skill in the art to include a transfix substrate comprising a fabric comprising a material selected from the group consisting of fabrics and metals, where the fabric material is selected from the group consisting of graphite fabric, fiberglass, cellulose and polyxylene in the image forming apparatus of Badesha '643 because Badesha '504 teaches the transfix component transfers and fuses the developed image (column 3, lines 50-51) where the fabric material improves mechanical strength and electrical insulating properties (column 8, lines 31-32).

NONSTATUTORY DOUBLE PATENTING

7. Claims 1, 4-8, 11-13, 15, and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 12-14 and 20 of Badesha et al. (U.S. 6,411,793) in view of Badesha et al (U.S. 5,846,643). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include an image forming apparatus for forming images on a recording medium comprising a charge retentive surface, a development component, a transfer component for transferring said developed image from said charge-retentive surface to an intermediate transfer component, an intermediate transfer component, a transfix component and a heating member associated with said transfix substrate.

Claims 1-4, 7 and 9 of Badesha '643 teaches a fuser member for use in an electrostatographic printing machine comprising an elastomer composition including a silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite. Badesha '793 and Badesha '643 are analogous art because they are from the same field of image forming apparatus. It would have been obvious to one of ordinary skill in the art to include the mica-type layered silicate elastomer in the transfix member of Badesha '793 because Badesha '643 teaches this silicate within fuser members are commonly known within the art, where fuser members have the same function as transfix members.

R s p o n s t o A r g u m n t s

8. Rejection of claims 1-10, 13-17 and 20 under 35 USC 102(b) as being anticipated by Badesha et al (U.S. 5,846,643) is withdrawn because Badesha does not explicitly disclose a transfix component. A new rejection of Claims 1-10, 13-17 and 20 made under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Swift et al (U.S. 6,381,436) has been established. Claims 11-12, 18-19 and 21 remain objected to, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR, EXAMINER
TELEPHONE CENTER 1700

